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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,122	09/30/2003	Jeyhan Karaoguz	14287US02	4964

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EXAMINER

MIZRAHI, DIANE D

ART UNIT	PAPER NUMBER
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2165

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/675,122

Applicant(s)

KARAOGUZ ET AL.

Examiner

DIANE D. MIZRAHI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-6-07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-32 are pending in the present application.

Claims 1-32 are rejected.

Drawings of 12/4/06 have been received.

This is in response to the Pre-Appeal Request for Review filed January 5, 2007 in which the rejection has been withdrawn and a new Office action is issued. See below:

Claim Rejections - 35 USC 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-32 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete.

See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02 and Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557). The decisions state to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. A claim limited to a machine or manufacture, which has a practical application, is statutory. Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557). That is, it must produce a "useful, concrete and tangible result". The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value as opposed to subject matter that represents nothing more than an idea or

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concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966); In re Fisher, 421 F.3d 1365, 76 USPQ 2d 1255 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ 2d 1600, 1603-06(Fed. Cir.1993)).

Applicant's independent claims 1, 11 and 21 recites conditional limitations for producing results, such as the claimed, "if said storage unit is transferred to a second location..." (Claim 5, for example), "such that the condition is not met, the claims will generate no useful, concrete, and tangible results. The result of the claimed, "transferring" is conditional and will take place only the claimed, "if said storage unit is transferred to a second location..." There appears to be no creation or transformation or production of any useful, concrete, and tangible results. Examiner recommends Applicant to amend the claims without adding any new matter to the originally filed specification.

Claims 2-10 are dependent claims and rejected under the same reasons as claim 1.

Claims 12-20 are dependent claims and rejected under the same reasons as claim 11.

Claims 22-32 are dependent claims and rejected under the same reasons as claim 21.

Regarding Claims 11-20, Examiner contends that computer programs do not define any structural and functional relationships between the computer program and other claimed elements of a computer which permit the computer's program functionality to be realized. Yet, a computer readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and thus is statutory.

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Regarding Claim 11, (for example), Applicant may select to amend the claims such that the limitation may read, "A computer readable storage medium having a code section...stored thereon code stored on a computer readable medium, which when executed would cause the computer to: store media and meta data...."

Claims 12-20 are dependent claims and rejected under the same reasons as claim 11.

Regarding independent Claims 1, 11 and 21, contends that the claimed, "storing.... transferred... presenting... receiving... displaying... does not produce a tangible result. (see claim 1 for example). Examiner recommends that to satisfy the 101 rejection, that the claims must produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77.

Claims 2-10 are dependent claims and rejected under the same reasons as claim 1.

Claims 12-20 are dependent claims and rejected under the same reasons as claim 11.

Claims 22-32 are dependent claims and rejected under the same reasons as claim 21.

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougall (US Publication No. 20030093485 and Dougall hereinafter) in view of Schrader et al. (U.S.

Publication # 20020166123 and Schrader hereinafter).

Regarding Claim 1, 11, and 21, Dougall teaches porting information between locations in a communication network[0034], the method comprising: storing media along with meta data associated with said stored media on a storage unit coupled to a communication device at a first location; if said storage unit is transferred to a second location and coupled to a second communication device at said second location, presenting a channel guide comprising representations of said stored media on a television [0061][0069] in said second location [0129][0023]; and in response to receiving a selection via said presented channel guide[0129], displaying at least one media file corresponding to said received selection on at least one of said television and a media player in said second location[0023].

In regards to the newly submitted limitation, “based on said meta data associated with said storage media on said transferred storage unit”

Dougall does not teach the claimed, “based on said meta data associated with said storage media on said transferred storage unit”.

Schrader teaches the claimed, “based on said meta data associated with said storage media on said transferred storage unit” [0126][0127][0129].

It would have been obvious to a person of ordinary skill in the art at the time of Applicant’s invention to modify the teachings of Dougall with the teachings of Schrader to include the claimed, “based on said meta data associated with said storage media on said transferred storage unit” with the motivation to enhance television viewing experience to users in

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a system and ... that utilizes real time and/or other data that is linked together with broadcast television programming.[0009].

Regarding Claim 2, Dougall teaches wherein said storage unit is a media processing unit [0069].

Regarding Claim 3, Dougall teaches receiving said stored media at said first location via at least one of a wired and a wireless interface [0064, 0069, 0079].

Regarding Claim 4, Dougall teaches displaying said meta data information associated with said displayed at least one file [0029, 0097].

Regarding Claims 5-6, Dougall teaches transferring at least a portion of said stored media from said storage unit to a storage device associated with said at least one of said television and a media player in said second location [0034][0030].

Regarding Claim 7, Dougall teaches scheduling ... based on at least a portion of said stored meta data [0024,0028,0119].

Regarding Claim 8, Dougall teaches generating at least a portion of said meta data by said storage unit [0088].

Regarding Claims 9-10, 12-20 and 22-32, these claims are similar in scope to the rejected claims above and are therefore rejected as set forth above.

Other Prior Art Made of Record

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Diane Mizrahi', is written over a horizontal line.

Diane Mizrahi
Primary Patent Examiner
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Technology Center 2100

April 8, 2007